

PATENT  
USSN 10/053,758  
Docket 002980US; 018/183c

### REMARKS

This paper is responsive to the Office Action dated August 10, 2005, which is the second action on the merits of the application.

Claims 1-16 and 23-26 were previously pending in the application; claims 1-8, 23, and 25 are under examination. No claims are amended, cancelled, or added in this response. Withdrawn claims 9-16, 24, and 26 are subject to a request for rejoinder pursuant to MPEP § 821.04.

Applicants gratefully acknowledge withdrawal of most of the rejections previously made. Only claims 23 and 25 are rejected under 35 USC § 112 ¶ 1. The only rejection remaining for the other claims under examination is for double patenting.

Reconsideration and allowance of the application is respectfully requested.

#### Interview summary:

The undersigned is grateful for the interview conducted with Examiner Ungar at the Patent Office on December 13, 2005. The undersigned explained how the rejected claims resemble genus claims that proviso out a subgenus, which is typical of claims in the chemical arts. The explanation is incorporated into the remarks presented here.

#### Priority:

In response to applicants' previous assertion that SEQ. ID NO:67 is entitled to a priority earlier than May 6, 1997, the Office Action has not assessed the matter further.

Applicants again assert that SEQ. ID NO:67 is entitled to priority at least to USSN 08/844,419 (filed April 18, 1997) and USSN 08/846,017 (filed April 25, 1997). Surely the Examiner will have access to these files through the efficient and reliable document storage and tracking service at the U.S. Patent & Trademark Office. In addition, USSN 09/766,253 is a continuation of the 08/846,017 application, and has issued as U.S. Patent 6,808,880.

SEQ. ID NO:67 of this application corresponds to SEQ. ID NO:67 of both USSN 08/844,419 and USSN 08/846,017.

The Office is respectfully requested to complete this analysis, or withdraw its previous assertion that the disclosure of SEQ. ID NO:67 could not claim priority prior to May 6, 1997.

PATENT  
USSN 10/053,758  
Docket 002980US; 018/183c

Rejection of claim 23

Claim 23 stands rejected under the written description requirement of 35 USC § 112 ¶ 1. The Office Action refers to MPEP § 2173.05(i) as requiring that “any negative limitation or exclusionary proviso must have basis in the disclosure”.

The Examiner is respectfully referred to the sentence immediately following quoted excerpt in MPEP § 2173.05(i):

If alternative elements are *positively* recited in the specification, then they may be explicitly *excluded* in the claims: See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187,196 (CCPA 1997) (“[the] specification, having described the whole, necessarily described the part remaining.”).

Applicants submit that the claim *does* have basis in the disclosure as filed, since both SEQ. ID NO:225 and SEQ. ID NO:67 (a portion of SEQ. ID NO:225) are both provided, and their use in producing antibodies is explained. In accordance with both MPEP § 2173.05(i) and *In re Johnson*, this application provides a full written description for an antibody that specifically binds SEQ. ID NO:225 *but not* SEQ. ID NO:67.

Withdrawal of this rejection is respectfully requested.

Rejection of claim 25

Claim 25 stands rejected on the assertion that the specification supports antibodies specific for a polypeptide *comprising* SEQ. ID NO:67, but not *consisting of* SEQ. ID NO:67.

Applicants respectfully disagree. Clearly, a polypeptide consisting of SEQ. ID NO:67 is a species of polypeptides comprising SEQ. ID NO:67, since the comprising language permits *but does not require* that additional amino acids be present in the polypeptide beyond SEQ. ID NO:67. Again, it is up to the applicants to decide what degree of protection they want — i.e., the genus, or the species.

Withdrawal of this rejection is respectfully requested.

PATENT  
USSN 10/053,758  
Docket 002980US; 018/183c

Double patenting:

Claims 1-8 stand rejected for obviousness-type double patenting over claims 50, 71, and 73 of USSN 09/721,477.

Applicants undertake to cancel these claims from the 09/721,477 application in response to the pending Office Action in that case. Withdrawal of this rejection is respectfully requested.

Request for Rejoinder:

Claims 9-16, 24, and 26 are method claims that incorporate limitations of the product claims under examination. Applicants hereby renew the request that these claims be rejoined into the group under examination, upon determination that the product claims are patentable, in accordance with MPEP § 821.04.

Applicants have amended claims 9 and 13 to reflect that it is SEQ. ID NO:225 that is being detected, in accordance with the Examiner's recommendation.

Request for Interview

Applicants respectfully request that all outstanding rejections be reconsidered and withdrawn. The application is believed to be in condition for allowance, and a prompt Notice of Allowance is requested.

In the event that the Examiner determines that there are other matters to be addressed, applicants hereby request an interview by telephone.

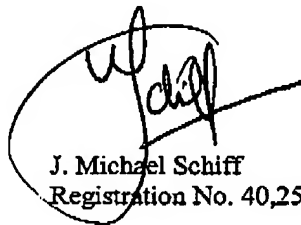
PATENT  
USSN 10/053,758  
Docket 002980US; 018/183c

Fees Due

Accompanying this Response is authorization to charge Deposit Account No. 07-1139 for the fees for the Extension of Time and the Request for Continued Examination. No other fee is believed payable with respect to the filing and consideration of this paper.

However, should the Patent Office determine that a further extension of time or any other relief is required for further consideration of this application, applicants hereby petition for such relief, and authorize the Commissioner to charge the cost of such petitions and other fees due in connection with the filing of these papers to Deposit Account No. 07-1139, referencing the docket number indicated above.

Respectfully submitted,



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